

### **REMARKS**

The pending Office Action addresses claims 1, 3-29, 31-44, 46-54, and 86-93. Claims 25, 29, 32, 39-44, 47, and 49-54 are withdrawn. Claims 1, 3-7, 11-23, 26-28, 30, 31, 33-38, 45, 46, 48, and 86-93 stand rejected. Applicants appreciate the Examiner's indication that claims 8-10, 24, 34, and 35 represent allowable subject matter.

#### ***Rejections Pursuant to 35 U.S.C. §102***

Claim 1 is amended to include the limitations of claim 14, which is now cancelled, and claim 26 is similarly amended to include the limitations of claim 27. Claims 1 and 26 also clarify that the curve *is adapted to match the contour of a spinal column*. This additional language does not necessitate a new search, as it is merely functional language and the limitations reciting the curvature were already present in claims 14 and 27. Accordingly, no new matter has been added, and entry of these amendments after final is respectfully requested.

#### ***Rejections Pursuant to 35 U.S.C. §102***

(1) *U.S. Patent No. 4,773,402 of Asher et al.*

##### **Claims 1, 3, 14, 17, and 18**

The Examiner continues to reject claims 1, 3, 14, 17, 18, 26, and 27 pursuant to 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,773,402 of Asher et al. Applicants continue to disagree.

At the outset, in the Examiner's response to Applicant's arguments, the Examiner states that Applicant admits that the Asher device does have arms slidably movable along the support. This is incorrect. Applicants state that the support moves along the arms – the arms do not slide along the support. In fact, the arms are fixed relative to one another by the base plate, thus the base plate

prevents the arms from sliding. Only the support can slide along the arms – the arms cannot slide along the support.

While Applicants and the Examiner continue to disagree as to whether Asher meets the slidable language of claim 1, the Examiner has overlooked another limitation of claim 1. Namely, claim 1 recites first and second arms each having a *proximal end* coupled to the elongate support member. The proximal end of the first and second arms of Asher are not coupled to the support. Rather, a mid-portion of each arm is coupled to the support (58). Thus, Asher cannot anticipate claim 1.

The Examiner also notes, in the response to Applicant's arguments, that the recitation of the distance between the arms is merely functional language. While Applicants agree that this language is functional, the Asher device must be capable of performing the claimed function. Claim 1 requires that the arms be slidably movable along the support member *to allow* a distance between the first and second arms to be adjusted. The arms of Asher do not slide to allow a distance between the arms to be adjusted, and they are not capable of sliding to allow a distance between the arms to be adjusted because the support and the base plate maintained the arms at a fixed distance relative to one another. The distance between the arms of Asher can never be adjusted, and thus the Asher device can never perform the claimed function.

Applicants further note that the support (58) of Asher is not curved to match the contour of a spinal column, and thus Asher is further precluded from anticipating claim 1.

Accordingly, independent claim 1, as well as claims 3, 14, 17, and 18 which depend therefrom, therefore distinguish over Asher.

#### Claims 26-27

Independent claim 26 requires an *adjustment mechanism* effective to allow slidable movement of a second member along an elongate support of a first member. The Examiner has yet

to point to an adjustment mechanism that allows slidable movement of the second member along the elongate support. Claim 26 also requires that the second arm have a first end adapted to slidably mate with and extend in a direction transverse to the elongate support of the first member. As explained above, Asher does not teach an arm having an *end* that mates to a support. Rather, the support is located at a mid-portion of the arms. Moreover, as stated above with respect to claim 1, the arms of Asher cannot slide along the support, rather only the support can slide along the arms. Asher is thus deficient for several reasons, and therefore claim 26, as well as claim 27 which depends therefrom, distinguish over Asher.

*(2) U.S. Patent No. 4,733,657 of Kluger*

Claims 26, 28, 31, and 33 are rejected pursuant to 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,733,657 of Kluger. While Applicants continue to disagree, as noted above claim 26 is amended to include the limitations of claim 27, thereby obviating the basis for this rejection. Accordingly, independent claim 26, as well as claims 28, 30, 31, and 33, which depends therefrom, therefore distinguish over Kluger.

*(3) U.S. Patent No. 5,423,826 of Coates et al.*

Claims 1-7, 11-13, 15-23, 26, 28, 30, 31, 36-38, 48, and 86-93 are rejected pursuant to 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,423,826 of Coates et al.

Claims 1-7, 11-13, and 15-23

While Applicants continue to disagree, as noted above claims 1 and 26 are amended to include the limitations of claims 14 and 27, respectively, thereby obviating the basis for this rejection.

Applicants note for the record, however, that the Examiner misinterpreted Applicants arguments. In the response to Applicants arguments, the Examiner states that Applicant's assessment of the arms "rotating" about the rod appears to be mistaken. Applicants do not argue

that the arms rotate about the rod – rather, Applicants explain that the rod rotates through the arms, and thus the arms do not slide along the rod. Where the Examiner relies on sliding movement occurring between the threads, then the thread on the arm does rotate about the thread on the rod, or vice versa. In either case, the arm itself does not *slide along* the rod. Applicants also note that the fact that the surface of the Coates device is threaded is relevant – the threaded surface prevents slidable movement. While Applicants have not claimed a “smooth” surface, the ordinary meaning of slidable requires a smooth continuous motion. Because the arm of Coates is threadably mated to the rod, the arm cannot move in a smooth continuous motion, and therefore Coates does not meet the limitations of claim 1.

Applicants further note that Coates does not teach arms having a proximal end coupled to a support, as further required by claim 1. Rather, the rod extends through a mid-portion of the arms. It does not mate to the proximal end of each arm. For the same reasons, Coates does not include a second arm having an end mated to the elongate support, as required by claim 26.

Accordingly, independent claims 1 and 26, as well as claims 2-7, 11-13, 15-23, 28, 30, 31, 36-38, and 48 which depend therefrom, therefore distinguish over Coates.

#### Claims 86-93

Claim 86 requires first and second guide members, with each guide member including opposed tabs extending distally therefrom. Coates does not include a guide member with opposed tabs. As shown in Figure 16, each guide member only includes a single hook (161) thereon. Claim 86, as well as claims 87-90 which depend therefrom, therefore distinguish over Coates.

Applicants further note that claim 86, as well as independent claim 91, also distinguishes over Coates for the same discussed above with respect to claims 1 and 26, namely Coates does not have first and second members that are slidably movable relative to one another. The arms on the Coates device do not “slide” relative to one another.

Accordingly, claims 86-93 therefore represent allowable subject matter.

***Conclusion***

Applicants submit that all pending claims are now in condition for allowance, and allowance thereof is respectfully requested. The Examiner is encouraged to telephone the undersigned attorney for Applicants if such communication is deemed to expedite prosecution of this application.

Respectfully submitted,

Date: July 24, 2007

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